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09/747,307	12/22/2000	Steve Bush	314768005US	2669

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EXAMINER

HAYES, JOHN W

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 12/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/747,307

Applicant(s)

BUSH ET AL.

Examiner

John W Hayes

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NW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18,52-63 and 73 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18,52-63 and 73 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. With respect to claims 16-18, applicant's arguments filed 01 October 2004 have been fully considered but they are not persuasive. Applicant argues that the prior art reference to Gautier fails to disclose combining the first and second accounts into a single account, however, this step is not recited in the claims. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., combining the first and second accounts into a single account) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The claims merely recite prompting the user to indicate whether the account identified by the received account identifier should be the same account as an account identified by an account identifier previously stored, without actually combining any accounts.
2. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-14 and 16-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

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For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. A claim limited to a machine or manufacture which has practical application in the technological arts is statutory. In most cases, a claim to a specific machine or manufacture will have practical application in the technological arts. See MPEP 2106, 2100-14 (quoting *In re Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1557). Additionally, for subject matter to be statutory, the claimed process must be limited to a practical application of the abstract idea or mathematical algorithm in the technological arts. See *In re Alappat* 33 F.3d at 1543, 31 USPQ2d at 1556-57 (quoting *Diamond V. Diehr*, 450 U.S. at 192, 209 USPQ at 10). For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. See *In re Musgrave*, 431 F.2d 882, 167 USPQ 280 (CCPA 1970).

In the present case, claims 1-14 and 16-18 only recite an abstract idea. The recited steps of merely assigning user identifiers to accounts and merging multiple accounts into a single account when the separate accounts represent the same account does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to assign and combine accounts. It is noted that the term "node" does not necessarily represent a computer node.

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble. In the present case, none of the recited steps are directed to anything in the technological arts as explained above with the exception of the recitation in the preamble that the method is a "computer based method". Looking at the claim as a whole, nothing the body of the claim recites any structure or functionality to suggest that a computer performs the recited steps. Therefore, the preamble is taken to merely recite a field of use.

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Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. An invention, which is eligible or patenting under 35 U.S.C. 101, is in the "useful arts" when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The fundamental test for patent eligibility is thus to determine whether the claimed invention produces a "use, concrete and tangible result". See *AT&T v. Excel Communications Inc.*, 172 F.3d at 1358, 50 USPQ2d at 1452 and *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d at 1373, 47 USPQ2d at 1601 (Fed. Cir. 1998). The test for practical application as applied by the examiner involves the determination of the following factors"

- (a) "Useful" – The Supreme Court in *Diamond v. Diehr* requires that the examiner look at the claimed invention as a whole and compare any asserted utility with the claimed invention to determine whether the asserted utility is accomplished. Applying utility case law the examiner will note that:
 - i. the utility need not be expressly recited in the claims, rather it may be inferred.
 - ii. if the utility is not asserted in the written description, then it must be well established.
- (b) "Tangible" – Applying *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994), the examiner will determine whether there is simply a mathematical construct claimed, such as a disembodied data structure and method of making it. If so, the claim involves no more than a manipulation of an abstract idea and therefore, is nonstatutory under 35 U.S.C. 101. In *Warmerdam* the abstract idea of a data structure became capable of producing a useful result when it was fixed in a tangible medium, which enabled its functionality to be realized.
- (c) "Concrete" – Another consideration is whether the invention produces a "concrete" result. Usually, this question arises when a result cannot be assured. An appropriate rejection under 35 U.S.C. 101 should be accompanied by a lack of enablement rejection, because the invention cannot operate as intended without undue experimentation.

In the present case, the claimed invention assigns user identifiers to accounts (i.e., repeatable) and combines multiple accounts into a single account when the multiple accounts represent the same account (i.e., useful and tangible).

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Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1-14 and 16-18 are deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 16-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Gautier, U.S. Patent Application Publication No. US 2004/0045031 A1.

As per **Claim 16**, Gautier discloses a method in a computer system for identifying common accounts, the method comprising:

- receiving a user identifier from a user (0042; 0044);
- sending a log on request to a server computer, the request including the received user identifier, but not including an account identifier (0042; 0044);
- receiving a log on response from the server, the response including an account identifier associated with the received user identifier (0042; 0044); and
- when the received account identifier does not match an account identifier previously stored at the node, prompting the user to indicate whether the account identified by the received account identifier should be the same account as an account identified by an account identifier previously stored at the node (0042; 0044).

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As per **Claims 17-18**, Gautier further discloses including when the user indicates that the accounts should be common accounts, sending a log on request to the server computer, the request including the received user identifier and an account identifier previously stored at the node (0042; 0044).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-15, 52-63 and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gautier, U.S. Patent Application Publication No. 2004/0045031 A1 in view of Hagan et al, U.S. Patent Application Publication No. 2001/0054155 A1.

As per **Claim 1**, Gautier discloses a computer-based method for identifying common accounts, the method comprising:

- assigning a first user identifier to a first account, the first account being associated with a first node (Figure 1; 0015; 0029);
- assigning a second user identifier to a second account, the second account being associated with a second node (0025; 0039; 0043);
- receiving a request from the second node that includes the first user identifier (0042);
- when the first account is not already associated to the second node,

determining whether the first and second accounts represent the same account (0042; 0044); and

Gautier, however, fails to explicitly disclose that when it is determined that the first and second accounts represent the same account, combining the first and second accounts into a single account. Gautier instead discloses maintaining two viewer accounts, however, associating the two viewer accounts with one network account. Hagan et al disclose a privacy and security method and system for a world wide web site and teach the establishment of accounts for users to compile medical history data wherein

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the user accounts are assigned an identifier (0030; 0052; 0062; 0065; 0068; 0069). Hagan et al further disclose a method for merging or combining two accounts into a single account for those users that have been assigned two different user identities in two separate accounts (0070). Accordingly, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Gautier and combine or merge the two user accounts into a single account such as that taught by Hagan et al for the benefit of easier management of the accounts. Hagan et al further notes that standard mailing-house merge-purge tools and methodologies can be used to merge two accounts (0070).

As per **Claim 2**, Gautier further discloses wherein the determining includes requesting a user to indicate whether the first and second accounts represent the same account (0042; 0044).

As per **Claim 3**, Gautier further discloses including identifying the second account to the user by specifying a user name associated with the second account (0041; 0042).

As per **Claim 4**, Gautier further discloses wherein when the user indicates that the first and second accounts represent the same account, requesting that the user provide credentials associated with the second account (0044).

As per **Claim 5**, Gautier further discloses wherein each account has a user and the user of the first account is the same as the user of the second account (0044).

As per **Claim 6**, Gautier further discloses wherein each account has a user and the user of the first account is not the same as the user of the second account (0043).

As per **Claims 7-8**, Gautier fails to specifically disclose deleting one of the accounts and assigning the user identifier assigned to the deleted account to the remaining account and associating with the remaining account a resource that was associated with the deleted account. Gautier instead discloses maintaining a second account, however, combining these accounts so that they are associated

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with a common network account. However, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to delete any additional accounts in a scenario where any additional accounts are assigned the same preferences, configurations or access rights. The motivation would be to reduce the number of accounts that have the same or similar settings or preferences in order to decrease the amount of processing necessary to manage the accounts.

As per Claim 9, Gautier further discloses when it is determined that the first and second accounts do not represent the same account, associating the first account with the second account (0044).

As per Claims 10, 52 and 58, Gautier discloses a computer-based method of generating a common account, one account being associated with a node, the method comprising:

- means for receiving at the node information relating to an account (0042-0044); and
- means for, when the account to which the information is related is not currently associated with the node,
 - determining whether the account associated with the node and the node not currently associated with the node should be common accounts (0042-0044).

Gautier, however, fails to explicitly disclose that when it is determined that the first and second accounts represent the same account, combining the first and second accounts into a single account. Gautier instead discloses maintaining two viewer accounts, however, associating the two viewer accounts with one network account. Hagan et al disclose a privacy and security method and system for a world wide web site and teach the establishment of accounts for users to compile medical history data wherein the user accounts are assigned an identifier (0030; 0052; 0062; 0065; 0068; 0069). Hagan et al further disclose a method for merging or combining two accounts into a single account for those users that have been assigned two different user identities in two separate accounts (0070). Accordingly, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Gautier and combine or merge the two user accounts into a single account such as that taught by Hagan et al for the benefit of easier management of the accounts. Hagan et al further notes that standard mailing-house merge-purge tools and methodologies can be used to merge two accounts (0070).

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As per Claims 11, 53 and 59, Gautier further discloses wherein the determining includes requesting a user to indicate whether the accounts are common accounts (0042; 0044).

As per Claims 12, 54 and 60, Gautier further discloses including identifying the account associated with the node to the user by specifying a user name associated with that account (0041; 0042).

As per Claims 13, 55 and 61, Gautier further discloses wherein each account is associated with one or more user identifiers (0026; 0042).

As per Claims 14, 56 and 62, Gautier further discloses wherein the information relating to the account is a user identifier associated with the account (0026; 0042).

As per Claims 15, 57 and 63, Gautier further discloses determining that the account to which the information is related is not currently associated with the node by receiving an indication of that account from another computer (0042).

As per Claim 73, Gautier discloses a method in a computer system for identifying common accounts, the method comprising:

- receiving a user identifier and password (0042; 0044);
- sending a log on request to a server computer, (0042; 0044);
- receiving a log on response from the server, the response including an account identifier associated with the received user identifier (0042; 0044); and
- when the received account identifier does not match an account identifier previously stored at the node, prompting the user to indicate whether the account identified by the received account identifier should be the same account as an account identified by an account identifier previously stored at the node (0042; 0044).

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Gautier, however, does not specifically disclose that the log on request includes an account identifier since the user is attempting to establish a second account that has not yet been assigned an account identifier. Examiner submits, however, that it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to send the existing account identifier in the log on request in order to enable the combining of a newly established second account identifier with the existing account identifier as suggested by Gautier.

Gautier further fails to explicitly disclose that when it is determined that the first and second accounts represent the same account, combining the first and second accounts into a single account. Gautier instead discloses maintaining two viewer accounts, however, associating the two viewer accounts with one network account. Hagan et al disclose a privacy and security method and system for a world wide web site and teach the establishment of accounts for users to compile medical history data wherein the user accounts are assigned an identifier (0030; 0052; 0062; 0065; 0068; 0069). Hagan et al further disclose a method for merging or combining two accounts into a single account for those users that have been assigned two different user identities in two separate accounts (0070). Accordingly, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Gautier and combine or merge the two user accounts into a single account such as that taught by Hagan et al for the benefit of easier management of the accounts. Hagan et al further notes that standard mailing-house merge-purge tools and methodologies can be used to merge two accounts (0070).

Conclusion

9. Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

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10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- O'Leary et al disclose combining two accounts into one
- Yun et al disclose a plurality of user accounts and merging one or more of the consumer's accounts

11. The prior art previously made of record and not relied upon is considered pertinent to applicant's disclosure.

- Swift et al disclose a method and apparatus for merging user accounts when security domains are merged
- Bennett et al disclose a financial information portal and teach wherein a financial institution enables the linking of user accounts with portal accounts also used by the user
- Dutcher et al disclose the use of multiple accounts for users wherein users can be authenticated by multiple domains using the same user ID and password
- Shockley et al disclose a method and system for alias detection that allows multiple accounts for the same user, however, each account is assigned specific rights or access.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hayes whose telephone number is (703)306-5447. The examiner can normally be reached Monday through Friday from 5:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 305-3900**. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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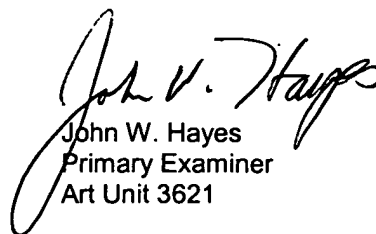
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Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington,
VA, 7th floor receptionist.


John W. Hayes
Primary Examiner
Art Unit 3621

December 17, 2004